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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,521	12/20/2001	Scott Powers	018781-004730US	6455
20350 7590 02/12/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER LI, RUIXIANG	
			ART UNIT 1646	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/028,521

Applicant(s)

POWERS ET AL.

Examiner

Ruixiang Li

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 11 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application, Amendments, and/or Claims

Applicants' response filed on 01/24/2007 has been entered in full. Claims 1-9 and 12-34 are canceled. Claims 10 and 11 are amended. Claim 35 is added. Claims 10, 11, and 35 are pending. Claims 10 and 11 are currently under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Withdrawn Objections and/or Rejections

The objection to title is withdrawn in view of amended title.

The objection to the disclosure is withdrawn in view of amendment to the specification.

The rejection of claims 7-9 under 35 U.S.C. 112, first paragraph for written description is withdrawn in view of amended and canceled claims.

The rejection of claims 7-10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 2 of U.S. Patent No. 6,635,741 B1 is withdrawn in view of canceled claims 7-9 and timely submitted terminal disclaimer.

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Drawings

The drawings submitted on 01/24/2007 are accepted.

Claim Rejections Under 35 U.S.C. §101, 35 U.S.C. §112, 1st Paragraph (Enablement)

The rejections of claims 10 and 11 under 35 U.S.C. § 101 and 35 U.S.C. §112, 1st paragraph are maintained. Claims 10 and 11 are rejected under 35 U.S.C. § 101 and 35 U.S.C. §112, 1st paragraph because the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well-established utility.

Applicants argue that the specification teaches that the polypeptide of SEQ ID NO: 18 may be used to test for inhibitors and activators of BCA-GPCR3 useful in the modulation of signaling pathways in, for example, breast cancer. Applicants also argue that subsequences [represented by SEQ ID NO: 18] have comparable functional activity to the [full length] BCA-GPCR3 polypeptide.

Applicants' argument has been fully considered, but is not deemed to be persuasive for the following reasons. First, while the specification (pages 44-45) discloses assays for modulators of BCA-GPCRs, the specification fails to disclose any specific functional activity of the BCA-GPCR-3 or a causal link between the BCA-GPCR-3 and any specific cancer. Secondly, the specification merely asserts that these subsequences have comparable functional activity to the BCA-GPCR-3 polypeptide set forth in SEQ ID NO:

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6, without indicating what functional activity it is. Thus, the instant disclosure fails to provide a patentable utility for the instantly claimed invention.

Claim Objection —Minor Informalities

The objection to claims 10 and 11 for reciting non-elected subject matter, i.e., the amino acid sequence of SEQ ID NO: 20. Appropriate correction is required.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875.

The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on (571) 272-0835. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at the toll-free phone number 866-217-9197.



Ruixiang Li, Ph.D.
Primary Examiner
February 5, 2007

RUIXIANG LI, PH.D.
PRIMARY EXAMINER